

REMARKS

All the previously pending claims (i.e., 47-74) have been cancelled and replaced with new Claims 75-94. It is believed that entry of the foregoing amendments will place the subject application in condition for allowance in view of the prior art cited to date. Specifically, independent Claims 75 and 92 now claim a support stand that, inter alia, has a rigid base, one or a pair of support members disposed on the base, and a securing apparatus that is capable of releasably securing a support member to the base in a way which prevents relative movement between the support member and the base. Nothing in the prior art cited to date teaches or suggests the claimed support stand either alone or in combination. Specifically, none of the cited art teaches a flat, planar, rigid base in combination with one or two support members that are slidably engaged with the top surface of the base and each of which has a single, planar holding surface. In view of these foregoing amendments and the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject application.

Previously pending Claims 47-55 and 57-60 were rejected under 35 USC 103(a) as being obvious over Smith et al., U.S. Patent 1,715,722 (hereinafter Smith). It was contended in the Office Action that Smith teaches all the elements of the rejected claims with the exception of claimed slot and sliding features, but that these features are mere design choice. The applicants respectfully disagree with this contention. As the new claims include many of the same elements found in the previously pending claims, the applicants also respectfully disagree with the aforementioned contention of obviousness as it applies to the new claims.

The Smith reference discloses a door-supporting vise which has a hinged base, rather than a rigid based as claimed by the applicants. Essentially, the Smith device includes a leaf spring 23 that pushes up against the bottom of the base so as to cause the two sides of the base 10, 11 to rotate about the hinge 12 and become upwardly tilted when no door is placed in the vise. The result is that the door gripping jaws 15

and 19, which are attached to the two sides of the base, respectively, open outward such that the distance between their door engaging portions 16 is greater at the open, top end of the jaws, than at the bottom end. This facilitates placement of a door into the vise owing to the distance between the door engaging portions of the jaws being larger than the edge of the door. Once the door is placed into the vise, its weight overcomes the upward force of the spring and the jaws rotate about the hinge to grip the door. It is also evident from the disclosed structure of the Smith device that when the door is lifted, weight is taken off the support vise, and the spring causes the jaws to rotate away from the door, thereby automatically releasing the door and facilitating its removal from the vise. While this structure is advantageous for the purpose of the Smith device, namely temporarily holding a door while fitting hinges thereto, it has significant disadvantages when used for other purposes. For instance, one of the uses supported by the applicants' claimed device is the holding of display panels for use at special events. As stated in the specification of the subject application:

"Hotels, Banquet Centers, Rental Companies and Decorators commonly supply consumers with display items of a flat panel type, such as a sheet of lattice or foam-core board to decorate and accent their special events, to act as a divider, sign or backdrop, or to block certain items from view. Such items often require a support device or support stand to hold them in a vertical position". (Page 1 – first paragraph of the Background section)

These display panels once set up must often be moved about both before and during an event. In addition, guests attending an event will often be milling about the display panels and may themselves attempt to move them. Moving such display panels typically involves lifting them. If the Smith device were being used, the support vise would automatically release, thereby requiring the vise to be picked up and repositioned at the panel's new location—an awkward and onerous task. The person moving the panel, such as a guest at the event, might even not notice the vise had released and set the panel down unsupported with potentially injurious results. On the other hand, the applicants' claimed support stand can be adjusted so as to grip the display panel

such that the stand does not come off when the panel is lifted and moved about, owing in part to its rigid base.

In view of the above-described differences between the claimed support stand and the vise disclosed in Smith, it is the applicants' position that Smith does not make the claimed stand obvious. In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a *prima facie* showing of obviousness must be made. To make a *prima facie* showing of obviousness, all the claimed elements of an applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no *prima facie* case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). In this case, the Smith reference lacks a teaching of the applicants' claimed rigid base. Thus, the claims recite an advantageous feature that is not taught in the Smith reference, and as such a *prima facie* case of obviousness has not been established.

Further, the claims are not obvious over the Smith reference because the hinged base of the Smith reference cannot be modified and made rigid without destroying the functionality of the support vise. The hinged and pre-tensioned base of Smith is key to its operation and its expressed advantages. Therefore, a worker would be driven to include the hinged feature of the Smith device in any combination device. If not, a primary function of the Smith invention would be destroyed.

It is well settled in the law that obviousness cannot be based on a modification of prior art that destroys the functionality of the invention disclosed in the prior art. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) it was held that a contention of obviousness based on such a modification is improper and does not establish a *prima facie* case of obviousness. There is simply no technological motivation for a worker to

make such a detrimental modification. To the contrary, a significant disincentive exists. In this case, making the base of the Smith vise rigid to match the applicants claimed support stand, would destroy a stated purpose for the Smith invention and so a *prima facie* case of obviousness cannot be established from the teachings of this reference.

In view of the lack of obviousness based on the Smith reference, it is submitted that new Claims 75-94 are patentable over the reference. As such, it is respectfully requested that these claims be allowed based on the nonobvious language, i.e.,

"A support stand, comprising...a flat, planar, rigid base...a pair of support members disposed on a top surface of the base, each support member having a single, planar holding surface... and wherein a first of the pair of support members is slidably engaged with the top surface of the base such that the holding surface of the first support member can be slid toward or away from the holding surface of the second support member".

Previously pending Claims 61-69 and 71-74 were rejected under 35 USC 103(a) as being obvious over Smith, in view of Morse, U.S. Patent 3,861,662. It was contended in the Office Action that Smith teaches all the elements of the rejected claims with the exception of the claimed wheels, but that Morse disclosed the wheel feature thereby making the claims obvious. In addition, previously pending Claim 56 was rejected under 35 USC 103(a) as being obvious over Smith, in view of Helfman et al., U.S. Patent 5,822,918 (hereinafter Helfman). It was contended in the Office Action that Smith teaches all the elements of the rejected claims with the exception of the claimed knob, but that Helfman disclosed this feature thereby making the claim obvious. And finally, previously pending Claim 70 was rejected under 35 USC 103(a) as being obvious over Smith, in view of Helfman, and in further view of Morse. It was contended in the Office Action that Smith and Helfman teach all the elements of the rejected claims with the exception of the claimed wheels, but that Morse disclosed this feature thereby making the claim obvious. The applicants respectfully disagree with the

foregoing contentions of obviousness for the same reasons described above in connection with the rejection of previously pending Claims 47-55 and 57-60 over Smith alone. As the new claims include many of the same elements found in the previously pending claims, the applicants also respectfully disagree with the aforementioned contentions of obviousness as they apply to the new claims.

In summary, it is believed that the foregoing amendments have placed the claims in condition for allowance. Therefore, consideration of new Claims 75-94 is respectfully requested. In addition, allowance of these claims at an early date is courteously solicited.

LYON, HARR & DEFRAK
300 Esplanade Drive
Suite 800
Oxnard, CA 93030
(805) 278-8855

Respectfully submitted



Richard T. Lyon
Reg. No. 37,385
Attorney for Applicant(s)